

Remarks

Claims 1-19 were previously pending in the subject application. By this Amendment claims 1, 16 and 17 have been amended and claims 3-5, 11, 12, 18, and 19 have been canceled. Accordingly, claims 1, 2, 6-10 and 13-17 are now before the examiner for consideration. In view of the amendments to the claims and the remarks below, favorable consideration of the claims now presented is earnestly solicited.

Claims 16 and 17 have been rejected under 35 U.S.C. §112, second paragraph. Please note that the applicants have amended claims 16 and 17 to depend from claim 1. In view of the amendments to the claims, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112.

Claims 1, 2, 6-10 and 13-17 have been rejected under 35 U.S.C. §102(a) as being anticipated by Momol *et al.* (*Phytopathology* 90(6):S127, June 2000). The applicants respectfully traverse this grounds for rejection because the Momol *et al.* (2000) reference is the inventors' own work which was published less than one year before the priority date for the subject application. Accordingly, this reference is not available as prior art under 35 U.S.C. §102.

Please note that the applicants' priority date is August 9, 2000, which is the filing date for their original provisional patent application (S.N. 60/223,903). Thus, the cited Momol *et al.* (2000) reference was published less than one year before the applicants' priority date. The applicants wish to point out that, to the extent that the Momol *et al.* (2000) reference discloses the current invention, this reference is the work of the current applicants.

Although an additional author is named on the Momol *et al.* (2000) abstract, this additional author did not contribute to the conception of the claimed subject matter. It is well recognized that the laws which govern inventorship determinations differ from the etiquette and customs applied to authorship determinations. To be an inventor, an individual must contribute to the conception of the claimed subject matter. In the current case the only individuals who contributed to the conception of the claimed subject matter were Timur M. Momol, David James Mitchell, Steve M. Olson and Esengul A. Momol. Although the contributions of the other individual were appreciated, and

warranted his inclusion as a co-author, his contributions were not to the conception of the invention and, thus, this individual could not be legally named as co-inventors on the current application.

"[O]ne's own invention, whatever the form of disclosure to the public, may not be prior art against oneself, absent a statutory bar." *In re Facius*, 161 USPQ 294, 301 (CCPA 1969). The Momol *et al.* (2000) reference is, as pointed out above, a disclosure by the inventors of their own work that was published less than one year prior to the filing date of the subject application. Therefore, under the authority of *In re Facius*, the disclosure contained in Momol *et al.* (2000) cannot be used as a reference against the applicants' claims. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102(a) based on the Momol *et al.* (2000) reference.

Claims 1, 2, 6-10 and 14-17 have been rejected under 35 U.S.C. 102(b) as being anticipated by Momol *et al.* (Phytopathology 89(6):S54, June 1999). Also, claims 1 and 13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Momol *et al.* (Phytopathology 89(6):S54, June 1999). The applicants respectfully traverse this grounds for rejection because the cited reference does not disclose or suggest the advantageous method claimed by the current applicants. Specifically, the claimed method advantageously provides a practical and effective method for controlling plant pathogens on plants. The cited reference only refers, in very general terms, to *in vitro* activity. An observation of some undisclosed level of *in vitro* activity does not establish that the method would have any usefulness under field conditions on live, growing plants.

It is basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference.

SSIH, supra; Kalman [v. Kimberly-Clarke, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

In *Dewey & Almy Chem. Co. v. Mimex Co.*, Judge Learned Hand wrote:

No doctrine of the patent law is better established than that a prior patent . . . to be an anticipation must bear within its four corners adequate directions for the practice [of the subsequent invention] . . . if the earlier disclosure offers no more than a starting point . . . if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation. 124 F.2d 986, 990; 52 USPQ 138 (2nd Cir. 1942).

The current claims specifically recite that the treatment is applied to a plant or its situs. By contrast, the cited reference specifically states that only *in vitro* results had been obtained. Accordingly, because the cited reference does not disclose each and every element of the claimed invention, it does not anticipate the claims under 35 U.S.C. §102(b).

A review of the cursory Momol *et al.* (1999) abstract reveals no experimental results and only a brief allusion to *in vitro* activity of thymol against *Ralstonia solanacearum*. This abstract does not teach using thyme oil to control plant pathogens on plants. Claim 1 has been amended to lend greater clarity by explicitly reciting that the treatment is applied to a plant or its situs. Certainly, the Momol *et al.* (1999) provides no teaching or suggestion of the excellent results achieved on live plants as reported in, for example, Table 1 in the subject application. The applicants respectfully submit that the extremely brief reference in the Momol *et al.* (1999) abstract to some undefined level of *in vitro* activity does not make obvious the applicants' highly effective and advantageous method for controlling plant pathogens on plants. Accordingly, the applicants respectfully request reconsideration and withdrawal of the prior art rejections based on the Momol *et al.* (1999) reference.

In view of the foregoing remarks and the amendment above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



David R. Saliwanchik

Patent Attorney

Registration No. 31,794

Phone: 352-375-8100

Fax No.: 352-372-5800

Address: 2421 N.W. 41st Street, Suite A-1
Gainesville, FL 32606-6669

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Attachment: Marked-up Version of Substitute Claims



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Marked-up Version of Substitute Claim Amendments

Claim 1 (amended):

A method for controlling a plant pathogen on a plant wherein said method comprises applying to said plant [pathogen] or its situs a pesticidally effective amount of a plant essential oil

Claim 16 (twice amended):

The method, according to claim 1 [16], wherein said plant pathogen is *Ralstonia solenacearum*.

Claim 17 (twice amended):

The method, according to claim 1 [17], wherein tomatoes are protected against said *Ralstonia solenacearum* by an essential oil from palmarosa or thyme.

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